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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,290	07/24/2001	Blake B. Bogrett	7150	5201
7590 06/09/2004				
Robert D. Touslee Johns Manville Corporation 10100 West Ute Avenue Littleton, CO 80127				
EXAMINER PIERCE, JEREMY R				
ART UNIT		PAPER NUMBER		
1771				

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,290

Applicant(s)

BOGRET ET AL.

Examiner

Jeremy R. Pierce

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on March 25, 2004 has been entered. Claim 1 has been amended. Claims 1-18 are currently pending, with claims 10-18 being withdrawn from consideration as non-elected claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites a "single blanket of resilient fibrous insulation having no folds therein." However, there is no support for a single blanket of resilient fibrous insulation having no folds therein in the specification. Negative limitations are not allowed in the claim unless expressly set forth in the specification. *Ex parte Grasselli*, 231 USPQ 393. The specification does not indicate that the fibrous layer cannot have folds.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Brandt et al. (WO 94/16162).

Brandt et al. disclose an insulating web comprising a fibrous non-woven web (page 1, lines 5-14). The fibers are generally oriented in a single predominant orientation determined by the orientation of the production line (page 1, lines 15-21). Brandt et al. teach folding the web transversely relative to the longitudinal direction so that the fibers are arranged perpendicular to the first longitudinal direction (page 3, line 22 –page 4, line 12 and Figures 9 and 10). Regarding the new limitation that the fibrous insulation has no folds, Brandt et al. teach an embodiment where the folds are removed from the fibrous insulation material (See Figures 8-10 and page 29, line 28 –page 31, line 15). The finished product in Figure 8, as seen in the drawing, does not contain any folds. Regarding Applicant's new use of "consisting essentially of" in claim 1, the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). The two outer layers shown in Figure 8 of Brandt et al. would not serve to materially affect the basic novel characteristic of the claimed invention

Art Unit: 1771

because the insulation material of Brandt et al. still has fibers that predominately lie in planes extending substantially perpendicular to the planes of the major surfaces and the end surfaces. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). With regard to claims 2 and 5, the fibers may be glass (page 1, line 7). With regard to claim 4, binder is used to bond the fibers (page 3, line 32).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt et al. in view of Michelsen (U.S. Patent No. 5,765,318).

Brandt et al. do not disclose using polymeric fibers. Michelsen teaches fibrous nonwoven insulation may be made from glass fibers or polymeric fibers. It would have been obvious to a person having ordinary skill in the art at the time of the invention to use polymeric fibers in Brandt et al. in order to use fibers that are easier to process and are recyclable, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re*

Leshin, 125 USPQ 416. Additionally, Brandt et al. does not disclose using a binderless web. Michelsen teaches that nonwoven insulation material may be held together by fibrous entanglement (column 4, lines 2-6). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use a binderless web in the Brandt et al. insulation in order to provide an insulation material with less weight and increased compressibility, by allowing the fibers to hold together without binder, as taught by Michelsen.

Response to Arguments

8. Applicant's arguments filed March 25, 2004 have been fully considered but they are not persuasive.

9. Applicant argues that Brandt et al. require folding to obtain a fiber orientation perpendicular to the first longitudinal direction of the insulating web. While folding may be required by Brandt et al., the claim only recites that the fibrous insulation not have any folds. As set forth above in the rejection, Brandt et al. teach an embodiment where the insulation does not have folds (Figure 8). Therefore, the claim limitation is met.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1771

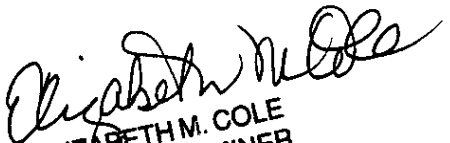
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ELIZABETH M. COLE
PRIMARY EXAMINER